

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS P. ROGERS

Appeal No. 95-2909
Application 08/048,270¹

HEARD: August 4, 1997

Before CALVERT, COHEN and FRANKFORT, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 and 5 to 7. The other claims in the application, 2 to 4 and 8 to 10, are indicated by the examiner as being allowable if rewritten in independent form.

¹ Application for patent filed April 14, 1993.

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The claims on appeal are directed to apparatus for exercising the arms.

The references relied upon by the examiner in rejecting the appealed claims are:

Hribar	4,146,222	Mar. 27, 1979
Gvoich et al. (Gvoich)	4,601,467	Jul. 22, 1986
Schaub et al. (Schaub)	4,848,739	Jul 18, 1989

The claims stand rejected as follows:²

- (1) Claims 1 and 5 to 7, unpatentable over Hribar under 35 U.S.C. § 102(b) or 103;
- (2) Claim 5, unpatentable over Hribar in view of Gvoich, under 35 U.S.C. § 103;
- (3) Claim 6, unpatentable over Hribar in view of Schaub, under 35 U.S.C. § 103;
- (4) Claim 6, unpatentable under 35 U.S.C. § 112, second paragraph.

Rejection (1)

Claims 1 and 7, the two independent claims on appeal, recite, inter alia, "at least two relatively movable paddles" (claim 1) or "a pair of relatively movable hollow paddles" (claim

² The claims were finally rejected as indicated in rejection (1). Rejections (2), (3) and (4) are new grounds of rejection, made in the Supplemental Examiner's Answer (Paper No. 14).

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7). The examiner asserts that the recited paddles are readable on elements 4 of Hribar. We do not agree.

It is fundamental that in construing claims, limitations from the specification will not be read thereinto, Sjoland v. Musland, 847 F.2d 1573, 1582, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988), and they will be given their broadest reasonable interpretation consistent with the specification. In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). Words in a claim will be given their ordinary and accustomed meaning, unless it appears that the inventor used them differently. Envirotech Corp. v. Al George, Inc., 730 F.2d 753, 759, 221 USPQ 473, 477 (Fed. Cir. 1984).

Applying these principles to the present case, it does not appear that appellant used the term "paddle" other than in its ordinary and accustomed meaning; therefore, we turn to the dictionary in order to construe the term. Cf. Nike Inc. v. Wolverine World Wide Inc., 43 F.3d 644, 647, 33 USPQ2d 1038, 1040 (Fed. Cir. 1994). The dictionary³ provides a number of different definitions of the word "paddle," of which the definition most consistent with the specification would appear to be "an implement suggestive in shape of a paddle," the shape of a paddle

³ Webster's Third New International Dictionary (1971).

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being "a rather short light wooden pole with a broad fairly flat blade at one end."

Elements 4 of Hribar do not meet this definition. They are described as "volumes . . . of the bladder type" (column 3, line 15) and are shown in the drawings (Figures 2 and 3) as rectangular in plan view. We see no structure of the Hribar "volumes" which would correspond to the pole (handle) and blade of a paddle and be "suggestive in shape of a paddle."

Moreover, we consider that the word "paddle," at least in this context, implies a structure that would include some type of handle portion, this being reinforced by the recitation in these claims that the paddles are part of "an arm exercising unit" (claim 1) or are "for furnishing arm exercise" (claim 7). The Hribar "volumes" 4 are not designed to be grasped, but rather are intended to be stood upon while walking, jogging, etc., and clearly do not include any kind of handle portion.

In addition, even if the Hribar "volumes" might be considered to be "paddles," they are not "relatively movable" as called for by the claims on appeal. Volumes 4 are confined by the sides 2 and bottom 3 of enclosure 1, covering 9, and tube connectors 10. While Hribar does disclose that volumes 4 "float" within enclosure 1 (column 3, lines 31 to 34), their relative expansion and contraction does not cause them to be relatively

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movable within the meaning of these claims. Reading the expression "relatively movable" in light of appellant's disclosure, it is evident that what is intended thereby is relative movability of each paddle relative to the other, not merely of a part of one paddle to a part of the other.

Accordingly, rejection (1) will not be sustained.

Rejections (2) and (3)

The Gvoich and Schaub secondary references applied in these rejections do not supply the deficiencies of the primary reference, Hribar, noted above. Rejections (2) and (3) will therefore not be sustained.

Rejection (4)

This rejection, made as a new ground of rejection in the Supplemental Examiner's Answer (Paper No. 14), is based on the examiner's holding that claim 6 is indefinite because the terms "said return line" and "said feedline" lack antecedent basis in parent claim 1, which "does not require a feedline that is separate from the return line" (Supplemental Examiner's Answer, page 6).

In response, the appellant filed a Reply to Supplemental Examiner's Answer and Amendment C; the latter paper amended claim 1 "to overcome a formal objection [sic: rejection] to claim 6 in the Supplemental Examiner's Answer." The examiner then issued a

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Second Supplemental Examiner's Answer (Paper No. 17), in which she reiterated that claim 6 was indefinite, without mentioning the amendment; apparently, from her comments, the amendment was overlooked.

Where, as here, an examiner's answer includes a new ground of rejection, the appellant may file a reply "accompanied by any amendment or material appropriate to the new ground." 37 CFR § 1.193(b). Since appellant's Amendment C appears to be limited to the new ground, it would be entitled to entry. See MPEP § 1208.03, citing Ex parte Abseck, 133 USPQ 411 (Sup. Exr. 1960). Accordingly, reading claim 1 as if Amendment C had been entered, we consider it to be evident that it overcomes the rejection of claim 6 under the second paragraph of 35 U.S.C. § 112.

We will therefore not sustain rejection (4).

Conclusion

The examiner's decision to reject claims 1 and 5 to 7 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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IRWIN CHARLES COHEN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND

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